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REMARKS

Claims 10, 20, 23, 24, and 29 have been canceled.

Claims 1-2, 6-7, 11, 13, 15-16, 18-19, 21, 25-26, 28, and 30-31 have been amended.

Except as noted below, the amendments to these claims have been made to clarify the language therein for clarity and consistency. No new matter has been added.

Reexamination and reconsideration are respectfully requested for claims 1-9, 11-19, 21-22, 25-28 and 30-31, which have been objected to or rejected in their originally presented respective forms, as follows.

THE CLAIM OBJECTIONS

Claim 7 has been objected to, the examiner noting that a roaming table is mentioned, but a roaming list should be referenced to be consistent with claim 6.

Claim 7 has been amended to specify a roaming list. This objection should therefore be withdrawn.

THE REJECTIONS UNDER §102

Claims 1-9, 15-19, and 26-28 and 30-31 have been rejected under 35 USC §102(b), the examiner alleging that they are fully met by Lee, et al. (USP 5,974,328). This rejection is respectfully traversed.

As amended, independent claims 1, 15, 26, 28, and 31 respectively recite that the mobile communication device has a locator which determines the location of the mobile communication device by a distance measuring technique. Thus, the actual location of the mobile communication device is known to the mobile communication device.

This is not shown or suggested by Lee, et al., in which the mobile communication device has no position location measuring function. Lee, et al. indicate at Col. 3, lines 6-10 that "the first step ... [is] to determine its [the mobile phone's] location from information gleaned from one or more channels in one or more frequency bands.... For example, ... the mobile phone monitors the channels until it identifies a SID, GID, and/or NID transmitted by the mobile phone system. Using this SID, GID, and/or NID, the mobile phone identifies its current location from a comparison with stored information...." Thus, Lee, et al., merely determine that the mobile phone is somewhere in a communication vicinity of a system having a recognized a SID, GID, and/or NID.

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For at least this reason, independent claims 1, 15, 26, 28, and 31, and the claims dependent therefrom are not full met by Lee, et al., and the rejection should be withdrawn.

THE §103 REJECTIONS

The examiner has rejected claims 10-14 and 20-25 under 35 USC §103(a), alleging that they are obvious from Lee, et al., in view of Dennison, et al., (USP 6,324,404). In his rejection, the examiner noted that Dennison, et al., use a GPS receiver for ascertaining the exact geographic location of a mobile communication device. The examiner then alleges that it would be obvious to use such locator in the system of Lee, et al. This rejection is respectfully traversed.

It is noted that the locator or its function has been incorporated into independent claims 1, 15, 26, 28, and 31; therefore, this rejection should be considered with respect to all of the claims currently in the application.

It is noted that although the examiner recited the factual inquiries set forth in *Graham V. John Deere Co*, 383 U.S. 1, 148 USPQ 459 (1966), he applied none. Instead, the examiner appears to have relied upon a correlation between the references being "of the same field of endeavor," with an unsupported conclusion that it would be obvious to use the "locator" of Dennison, et al., in the Lee, et al., system. It is respectfully suggested that more is required. Specifically, in order to combine the teachings of the references, there must be a suggestion within the references to combine. As succinctly stated in the MPEP, to establish a *prima facie* case of obviousness, three basic criteria must be satisfied: (1) a suggestion or motivation to modify the cited reference or to combine the teachings in the cited references; (2) a reasonable expectation of success; and (3) the cited references must teach or suggest all the claim limitations. *See*, MPEP §706.02(j). The cited references "must expressly or impliedly suggest the claimed invention...."

The MPEP summarizes the progression of requirements imposed on prosecution practice by decisions of the Court of Appeals, Federal Circuit, a progression of decisions beginning with *In re Fine* and extending through *In re Fitch*. Briefly, the Court held in *In re Fine* that "[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so...." *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598-99 (Fed. Cir. 1988). Further, the same prior art must "provide one of ordinary skill in the art the motivation to make

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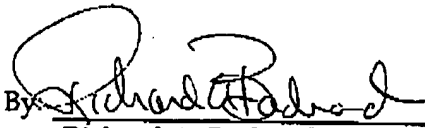
the...modifications.... "In re Fine, at 1944. The Federal Circuit has held that the requirement that any modification suggested by the Examiner is not obvious unless the prior art suggests the desirability for the modification. In re Fitch, 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

In the present case, there is no suggestion in either reference to combine the teachings. In Fine, et al., there position is determined by matching signals in a particular cell vicinity. External measurements are not contemplated, or, in fact, useful. On the other hand, Dennison, et al., uses GPS derived information to send to a base station for some base station action. (See, Col. 9, line 25 *et seq.*) This does not appear to have the effect of accelerating acquisition of a preferred system. Thus, it is respectfully submitted that because there is no suggestion to combine the references, it would not be obvious to do so. For at least this reason the rejection should be withdrawn.

Applicant therefore respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

Dated: May 20, 2004

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